Claim Rejections under 35 USC §103

The Examiner has rejected claims 1-3, 5-11, 13, 15-16, and 19-31, as unpatentable per Schwebel (published application) in view of Rhoades, combined in a third citation with the elements of press-on lenses of Einhorn.

Applicant's device features a pair of soft, pliable, curved lenses, each of which is engaged within a soft pliable frame. These two soft pliable frames allow independent coverage of each eye of the user. A soft pliable gasket on a back portion of each of the two frames substantially encircles orbital bone of the eye socket of the wearer the individual frame surrounds.

A bridge couples the two frames and a flexible provides a means to maintain said apparatus on a wearer. Applicant's device thus yields two separate soft pliable frames, individually in a sealed engagement with a respective eye, providing, and for the purpose of, increasing or maintaining the humidity around the eyes of the wearer, by reducing the evaporation of natural or artificial tears or with added moisture.

The cited references in this second refusal, appear to have been found after a thorough search of the prior art for the individual features of Applicants' invention. A rejection based on such a hindsight selection of features is improper. As the Court of Appeals for the Federal Circuit said in Connell et al. v. Sears, Roebuck & Co. (CA FC, 1983), 20 USPG 193 at 199:

> "The opinion says obviousness is established when 'features that distinguish' the invention from the closest reference 'are disclosed in analogous structures in which the features perform the identical function'. It is not 'features' but the subject matter as a whole which must be considered, 35 U.S.C. 103. That features, even distinguishing features, are 'disclosed in the prior art' is alone insufficient. As above indicated, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made."

Schwebel, in all depicted and taught embodiments, forms a single chamber that communicates with both eyes at once as shown in figures 1, and also in figure 3 where the seal (38) is placed around the perimeter (42) and the chamber formed by the two lenses (40) communicating with a chamber across the bridge. (Paragraph 42). The general principal of this paragraph, that the single chamber can be adapted to other forms of eyewear

Nothing in Schwebel teaches or suggests eyewear with two individual chambers to individually concurrently treat two eyes, or, engaging soft lenses directly with two connected pliable frames. In fact, Schwebel teaches the use of prescription lenses (paragraph 27) engaged with an wire that supports it (paragraph 43) and in all embodiments shown in the figures, there is a single pre-corneal humidity chamber. This single chamber is

shown in figure 1, and in figure 3 where the chamber is in communication across a bridge shown in figure 3 connecting both eyes. The general principal of using a non flexible lens engaged to a frame to form a single chamber is what is adaptable to other forms of eyewear in the overreaching statement in Schwebel.

The Examiner cites Rhodes as an example of a soft pliable frame. However Rhoades teaches a device for to keep moisture out of the eye chambers which is exactly the opposite of applicant's device. Further, the lenses of Rhoades are not curved or flexible lenses as claimed by applicant. In fact, as noted in column 5, lines 45-55, the lenses are those known in the field of specialty including prescription or other plain glass lenses that allow the Rhoades device to work under water where the lens is pressured by the water, or above water as eyeglasses where the lenses would be prescription. Soft lenses thus will not work with Rhodes as they would collapse and deform under water and would not work for prescription lenses unless they remain in plane to provide the optical qualities.

Further, the device of Rhoades is designed to keep moisture out of the chambers. Under water there is intended a water tight seal to keep water out. Above ground, Rhoades specifically vents moisture so the lenses (prescription or other glass) don't fog. (Column 5 lines 45-56, column 6 lines 28-31). This is exactly the opposite of applicant's device which retains or provides moisture to the chambers to impart it to the eyes.

> [1] Neither apparatus nor process claims can properly be rejected on a combination of steps or elements allegedly drawn from prior art disclosures where the steps or elements must be modified to meet the claims, and where both the combination and the modifications must be made *in light of the applicant's own teachings*, rather than in the light of any suggestions derivable from the prior art itself. *Walker v. Ladd, Comr. Pats . DCDC 138 USPQ 386 at 388 1963*

Rhoades thus does not teach a device for maintaining moisture around the eyes but one that vents it and keeps the eyes dry. Further Rhoades teaches solid prescription or other glass lenses to allow the user to see through them in an optically correct or corrected fashion and must have such solid lenses to operate underwater.

Nothing in Schwebel teaches or suggests eyewear with two individual chambers to individually impart moisture to individual eyes. Schwebel too teaches the use of prescription lenses engaged with an wire and in all embodiments shown in the figures, there is a single pre-corneal humidity chamber.

Thus the provision of separate chambers to each eye, to maintain or add moisture therein to impart it to each eye, and the use of soft flexible lenses for comfort when lying face down, is a combination only taught by applicant, and the examiner suggested modifications have be made in light of the applicant's own teachings, rather than in the light of any suggestions derivable from the prior art.

Finally, the Examiner citation of Einhorn for the element of flexible lenses would not function in the manner suggested. Einhorn has solid lenses engaged within wire frames. (Figures 1-2). The temporary flexible lenses of Einhorn will not function or mount, without the solid lenses engaged in the frame. The flexible lenses of Einhorn are intended to engage upon the surface of solid prescription lenses to alter a small area of the view therethrough. (Column 2, lines 1-13). The Einhorn lenses as taught, are press-on lenses that must overlay a pair of solid prescription lenses. (Column 2 lines 25-30). Due to their thin, soft nature, they can be placed over normal prescription lenses and are mounted only to those lenses by electrostatic force. Einhorn neither teaches or suggests flexible lenses that are engaged to the frame. The flexible lenses of Einhorn are incapable of engagement with a frame as claimed by applicant's device and cannot mount or function without a solid prescription or other solid lens, engaged to the frame for a mount.

The importance of using this soft pliable structure for lens and eyecup (frame) is taught by Applicant at paragraphs 42 and 43, wherein it notes the design of applicant's device minimizes pressure on the points where applicant's invention meets the face (and capillaries and blood vessels) especially when the user lies on a pillow face down. Obviously if rigid walls are used as in the prior art, the pressure from the entire frontal surface area of the device, is transmitted from the surface area of the rigid lenses to the rigid sidewalls, and communicated to the contact points of the sidewalls on the face.

Further, as noted in paragraph 49, at page 12, and through paragraph 51, comfort and the reduction of pressure points in the contact area, was the primary criteria used in Applicant's design and employment of soft pliable lens and frame materials. As noted above, the use of these soft pliable materials reduces capillary blockage and other hazards caused by, and amplified by the rigid design for the lenses, taught by Schwebel. Through using soft pliable material for lenses and eyecups, Applicants soft frame, and soft pliable lenses engaged in that frame, will bend and fold under pressure rather than communicate surface pressure and even if collapsed. As further noted in paragraph 51, when the user is face down, such as in a Spa or on a massage table, the unique design of Applicant's device with soft pliable lenses and frame, eliminates the additional loading created by the face on the pillow, since the lenses and frame bend instead of transmitting the force to the wearer's face.

The suggested modification of the Examiner to employ soft lenses engaged directly to a soft pliable frame, is thus made in light of applicant's own teachings, and void of any teaching in the cited art, all of which teaches solid non flexible lenses engaged to frames and all of which teach against such a lens construction or engaging soft flexible lenses to a soft flexible frame. The sole mention of a flexible lens actually mounts a small thin lens upon the surface of a larger solid non-flexible

solid lens engaged with a frame. Neither does the prior art teach or suggest the employment of separated eye chambers which have soft pliable lenses and frames to keep moisture and humidity inside the separate chambers.

The cited prior art in fact teaches against the employment of soft pliable frames engaged with soft pliable lenses to yield separated chambers to keep moisture inside. As such, claims 1, 19, 22, 24, and 25, and dependant claims thereto, claim elements in combination which provide function and utility that is neither taught, nor suggested by the cited prior art. The objections of the Examiner are respectfully traversed.

Final Remarks

No new matter or changes has been added to the claims which have been shown to have structure yielding function neither taught or suggested by the cited prior art.

EVEN MINOR IMPROVEMENTS ARGUE FOR PATENTABILITY

Still further, it was noted in an earlier action, that applicant's device as claimed provides a device yielding functions which neither taught or suggested by any of the numerous citations of prior art in this crowded field. The differences in Applicant's device, represent a novel arrangement which provides useful characteristics taught in the cited prior art.

It is therefor submitted that applicant's invention is in the form of a meritorious improvement in the art, which even though it may be considered simple, it is not anticipated by citeable prior art, nor is it believed to be fairly suggested by the cited references.

It is well established that one should not be deprived of patent protection, where it can be shown that a genuine improvement has been made, on comparison with other inventions in the art, even if the improvement lacks the appearance of a great advance in the art.

In re Lange, 128 USPQ 365, the CCPA on page 367 states that:

> "We think that the present application is a distinct improvement of Jezalik and represents an advance in the art not obvious, having patentable novelty. The art is a crowded and comparatively simple on and in such an art, great advances are not to be expected. However patentability will not be denied to an invention which accomplishes a small, but nevertheless genuine improvement not though of by others."

Further, the CCPA in the recent case of re Meng and Driessen, 181 USPQ 94, on page 97, reiterated the principal that even though the invention seems *simple, after the fact,* simplicity, particularly in an old and crowded art, argues *for,* rather than against, patentabilty.

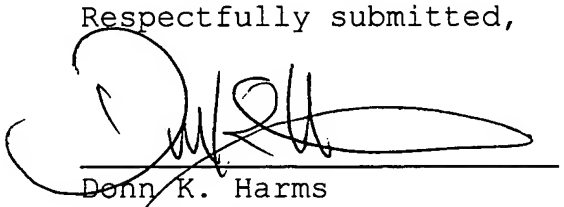
Applicant's device provides genuine improvement in products for th provision of eye treatment and is believed to be a significant advance over the prior art. However, even if applicant's device is only a small advance, case law, and the CCPA as noted above, have clearly indicated such small advances,

especially in a crowded art, are patentable.

As such all remaining claims in the application should now be allowable.

Should the Examiner have any further questions or concerns the Examiner wishes to address by Examiner's amendment by telephone or otherwise, or should the Examiner have suggestions to more clearly define the subject matter of the claims to more clearly define the patentable subject matter, the Applicant's attorney would be most receptive to such by Examiner's amendment through telephonic review.

Respectfully submitted,



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